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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/825,285

04/04/2001

Raymond John Herbert

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SHOEMAKER AND MATTARE, LTD  
10 POST OFFICE ROAD - SUITE 110  
SILVER SPRING, MD 20910

EXAMINER

WORJLOH, JALATEE

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

07/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/825,285	<b>Applicant(s)</b> HERBERT, RAYMOND JOHN	
	<b>Examiner</b> Jalatee Worjloh	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 16, 2008 has been entered.
2. Claims 3-9 are pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 6, 7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 6 recites the limitation "the detection means" in 7. There is insufficient antecedent basis for this limitation in the claim.
6. The term "operatively" in claim 9 is a relative term which renders the claim indefinite. The term "operatively" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The phrase "operatively link" does not define a range, it is therefore unclear whether or not the sensor is linked.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5683190 to Gawler in view of US Patent No. 7069247 to Oppedahl.

Referring to claim 3, Gawler discloses feeding a mail piece along a feed bed (see abstract, fig. 1, and col. 2, lines 34-38), utilizing a sensor to scan a band on the fed mail piece to detect a sequence and generating an indication of a presence of the imprint of the postal indicium in response to detection (see col. 3, lines 65-56 and col. 4, lines 1-5 – a sensor senses when the leading edge of the mail item passes a predetermined location along the feed bed and outputs a control signal). Gawler does not expressly disclose detecting a sequence of transitions between areas of light and dark reflectance with the band, the band extending across the location and generating an indication in response to detection of a transition succeeding a predetermined number of initial transitions at a start of the sequence transaction. Oppedahl discloses detecting transitions between areas of light and dark reflectance with a band (see col. 3, lines 48-51). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Gawler to detect the elements of Oppedahl. One of ordinary skill in the art would have been motivated to do this because it provides a method for effectively verifying mail pieces (see Oppedahl, col. 2, lines 30-32 ).

Referring to claims 4 and 5, Gawler discloses postal indicium (see claim 3 above).

Gawler does not expressly disclose the postal indicium includes an area in which postal data is printed in machine readable, two dimensional or data matrix form. Oppedahl the postal indicium includes an area in which postal data is printed in machine readable, two dimensional or data matrix form and cryptographic data (see abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the postal indicium of Gawler to include an area in which postal data is printed in machine readable, two dimensional or data matrix form and cryptographic data. One of ordinary skill in the art would have been motivated to do this it provides a method for effectively verifying mail pieces (see Oppedahl, col. 2, lines 30-32 ).

Claims 6 and 8 are rejected on the same rationale as claim 3 above.

9. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gawler and Oppedahl as applied to claims 6 and 9 above, and further in view of US Patent No. 5907833 to Lee.

Referring to claim 7, Gawler in combination with Oppedahl disclose the features of claim 6. Gawler does not expressly disclose stopping the feeding of further mail pieces past the print head in the event that no postal indicium is detected on the fed mail piece. Lee discloses stopping the feeding of further mail pieces past the print head in the event that no postal indicium is detected on the fed mail piece (see fig. 3, block 55 & related text). At the time the invention was made it would have been obvious to a person of ordinary skill in the art to modify Gawler to stop feeding mail pieces past the print head in the event that no postal indicium is detected on the

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fed mail piece. One of ordinary skill in the art would have been motivated to do this because it reduces mail piece feeding errors.

Referring to claim 9, Gawler in combination with Oppedahl and Lee discloses the features of claim 9 (see claim 8 above & Lee, Fig. 5, and associated text).

### ***Conclusion***

Applicant is reminded that functional recitation(s) using the word “for” or other functional language (*e.g.* “operable to”), as recited in claims 8 and 9, have been considered but are given little patentable weight<sup>1</sup> because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

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<sup>1</sup> See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685

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although all limitations must be considered, not all limitations are entitled to patentable weight).